

Remarks:

This amendment is responsive to the Office action dated June 19, 2006, and is being filed under 37 C.F.R. § 1.111. Claims 1-27 are pending in the application. In the Office action, the Examiner (1) rejected claims 14, 20, 21, and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite; and (2) rejected each of the pending claims under 35 U.S.C. § 103(a) as being unpatentable over a combination of references. Applicant traverses the rejections, contending that each of the pending claims is definite and is patentable over the cited references.

Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicant would like to patent now, applicant has (1) canceled claims 8, 11-14, and 21-27, without prejudice; and (2) amended claims 1, 9, 10, 15, 19, and 20. Applicant reserves the right to pursue the canceled claims, in original or amended form, at a later time. Furthermore, applicant has presented arguments showing that claims 1-7, 9, 10, and 15-20 are not indefinite and are patentable over the cited references. Accordingly, in view of the foregoing amendments and the following remarks, applicant respectfully requests reconsideration of the application under 37 C.F.R. § 1.111 and allowance of the pending claims.

I. Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 14, 20, 21, and 26 under 35 U.S.C. § 112, second paragraph, as being indefinite. In particular, the Examiner rejected each of claims 14, 20, and 26 for including the term "substantially equal to." Furthermore, the Examiner rejected claim 21 for reciting a processor comprising a "site." Applicant traverses the

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rejections under Section 112, contending that each of the pending claims is definite as written. Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicant would like to patent now, applicant has amended claim 20 to delete the term "substantially equal to." Furthermore, applicant has canceled claims 14, 21, and 26, without prejudice. Accordingly, each rejection under 35 U.S.C. § 112 should be rendered moot.

II. Claim Rejections - 35 U.S.C. § 103

The Examiner rejected each of the pending claims under 35 U.S.C. § 103(a) over a combination of references. Claims 1-4, 7, 8, and 11-27 were rejected as being unpatentable over Linden (U.S. Patent No. 6,912,505) in view of Herz (U.S. Patent No. 6,571,279). In addition, claims 5, 6, 9, and 10 were rejected as being unpatentable over Linden in view of Herz and DeLapa (U.S. Patent No. 6,076,068). Applicant traverses the rejections, contending that it would not have been obvious to combine the cited references. Nevertheless, to expedite the issuance of a patent, and to more particularly point out and distinctly claim aspects of the invention that applicant would like to patent now, applicant has canceled claims 8, 11-14, and 21-27, without prejudice; and has amended claims 1, 9, 10, 15, 19, and 20. (The amendments to claims 9, 10, and 19 are intended to improve clarity and/or to address formal issues created by the amendments to independent claims 1 and 15.) Independent claims 1 and 15, and all of their dependent claims, are patentable for the reasons set forth below.

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A. Claims 1-10

Claim 1, as amended, is directed to a method of providing coupons:

1. (Currently Amended) A method of providing coupons, the method comprising the steps of:
 - identifying items in a current transaction;
 - assigning an expected value to each coupon of a coupon set based on a comparison of the identified items with a predictor set that links expected value to each coupon of the coupon set;
 - selecting a coupon from the coupon set and a characteristic of the coupon based on the expected value of the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color; and
 - printing the selected coupon with the selected characteristic.

Exemplary support for the amendments to claim 1 are included in the application, for example, on page 12, lines 12-18. In the Office action, the Examiner rejected claim 1 as being obvious over a combination of Linden and Herz. Applicant traverses the rejection because the cited references, taken alone or in combination, do not teach or suggest every element of claim 1. For example, the cited references do not teach or suggest selecting "a characteristic of the coupon based on the expected value of the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color" and "printing the selected coupon with the selected characteristic."

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Linden relates predominantly to the use of product viewing histories, such as a history of web browsing, to identify related products. However, Linden also discloses recommendations offered to customers within physical stores (col. 30, line 56, to col. 31, line 12). For example, Linden discloses providing a discount coupon to a user at check-out time based on the items purchased by the user. Nevertheless, Linden does not teach or suggest selecting a coupon based on the expected value of the coupon, as recited by claim 1. In the Office action, the Examiner agreed that Linden does not involve a coupon selection based on the expected value of the coupon. Accordingly, Linden particularly does not teach or suggest selecting a coupon and a characteristic of the coupon based on the expected value of the coupon.

Herz relates to a location enhanced information delivery system. For example, Herz discloses an in-store version of the system that relies on "shopper loyalty" cards. The cards are used to identify each shopper at the check-out counter, to allow generation of a detailed shopper profile over the course of several store visits. More particularly, Herz states that "in time, the vendor develops a highly detailed database that connects shoppers to purchase items, prices and coupons" (col. 23, lines 8 and 9). The system of Herz also involves presenting the shopper with coupons and promotions at an in-store electronic kiosk (but not the check-out counter), based on the shopper's profile.

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In the Office action, the Examiner asserted that Herz discloses changes in coupon appearance as the expected value of the coupon changes, citing column 24, lines 34-36, of Herz. However, the cited portion of Herz relates only to determining "optimal price points" of coupons. Applicant submits that selection of an optimal price point of a coupon affects only a numerical discount or product price included in the coupon (e.g., "\$.25 off," "\$.30 off," or "\$.35 off"). The selection of a numerical discount or product price for the coupon would have no effect on the coupon's size, print quality, spacing, position, orientation. Accordingly, Herz does not teach or suggest selecting a characteristic of the coupon based on the expected value of the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color, as recited by amended claim 1.

DeLapa also was cited in the Office action, in combination with Linden and Herz, for rejection of claims 5, 6, 9, and 10. DeLapa relates to a coupon delivery system located at a computer-based kiosk in a retail establishment such as a grocery store. In the Office action, the Examiner stated: "DeLapa teaches a targeted coupon printing method in which household-specific messages may be printed with the coupons (thus changing the appearance)." However, the messages of DeLapa are not coupons with an expected value assigned according to items identified in a current transaction, as recited by claim 1. Furthermore, DeLapa does not teach or suggest selecting a characteristic of the coupon based on the expected value the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color, as recited by claim 1.

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In summary, none of the cited references, taken alone or in combination teach or suggest every element of amended claim 1. Accordingly, claim 1 should be allowed. Claims 2-7, 9, and 10, which depend from claim 1, also should be allowed for least the same reasons as claim 1.

B. Claims 15-20

Claim 15, as amended, is directed to a system for printing coupons:

15. (Currently Amended) A system for printing coupons, comprising:
an input device configured to identify items in a current transaction;
a processor that includes a correlation data structure in which each coupon of a coupon set is linked to a predictor set and an expected value, where the processor is operatively connected to the input device and configured to create a transaction file from the identified items, to assign the expected value to each coupon of the coupon set based on a comparison of the transaction file with the predictor set of each coupon, and to select a coupon of the coupon set and a characteristic of the coupon based on the expected value of the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color; and
a printer operatively connected to the processor and configured to print the coupon with the characteristic selected by the processor.

Exemplary support for the amendments to claim 15 are included in the application, for example, on page 12, lines 12-18. In the Office action, the Examiner rejected claim 15 as being obvious over a combination of Linden and Herz. DeLapa was cited in rejection of other pending claims. Applicant traverses the rejection because the three cited references, taken alone or in combination, do not teach or suggest every element of claim 15. For example, based on the discussion presented above in relation to claim 1, the three cited references do not teach or suggest a processor configured to select "a

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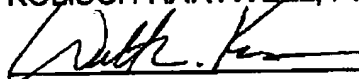
characteristic of the coupon based on the expected value of the coupon, the characteristic corresponding to one or more of size, print quality, spacing, position, orientation, and color" and a printer configured "to print the selected coupon with the characteristic selected by the processor." Accordingly, claim 15 should be allowed. Claims 16-20, which depend from claim 15, also should be allowed for least the same reasons as claim 15.

III. Conclusion

Applicant believes that this application is now in condition for allowance, in view of the above amendments and remarks. Accordingly, applicant respectfully requests that the Examiner issue a Notice of Allowability covering the pending claims. If the Examiner has any questions, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned attorney of record.

Respectfully submitted,

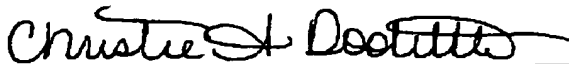
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to Examiner Michael Bekerman, Assistant Commissioner for Patents, at facsimile number (571) 273-8300 on September 18, 2006.



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